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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/786,616

03/06/2001

Laurent Gauche

PF980061

3464

24498

7590

05/18/2005

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EXAMINER

PICH, PONNOREAY

ART UNIT

PAPER NUMBER

2135

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,616

Applicant(s)

GAUCHE, LAURENT

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-9 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 2-4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 2, 4, 7, and 9 have been amended. Claims 1-9 have been considered and are pending. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Docketing

Please note that the application has been redocketed to a different examiner. Please refer all future communications regarding this application to the examiner of record using the information supplied in the final section of the office action.

Response to Arguments

Applicant's arguments, filed 1/21/2005, with respect to claims 1-9 have been fully considered and are persuasive. The previous examiner's rejections of claims 1-9 have been withdrawn. However, the new examiner will make any new rejections to the claims as appropriate, see below.

Response to Amendment

The examiner has considered the amendments to claims 2, 4, 7, and 9 and will make any new rejections as appropriate.

Claim Objections

Claims 1-9 are objected to because of the following informalities: The examiner respectfully suggests that the applicant begin each claim with an article. For example, "A conditional access system ...", "The decoder according to claim ...", "A method ...", and "The method according to claim ...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. As per claim 1, line 8, the applicant recites, "wherein it comprises". It is unclear to what "it" is referring. The examiner will in the course of examining this application assume "it" refers to the decoder.
2. As per claim 2, line 11, the applicant recites, "wherein it comprises". It is unclear to what "it" is referring. The examiner will in the course of examining this application assume "it" refers to the decoder.
3. Any claims not specifically addressed are rejected by virtue of dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muratani et al (US 6,061,451) in view of Chaney (US 6,035,037).

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Claim 1:

Muratani discloses that at the time the applicant's invention was made, it was known in the art a conditional access system decoder comprising:

1. At least one device intended to read and/or to write data from/to a detachable security element supplied by a service provider (col 1, lines 54-60 and Fig 1).
2. Filters intended to select at least one message for managing entitlements which a user possess with regard to a service supplied by said provider from among a data stream received (Fig 1, item 24 and col 2, lines 4-12).

Muratani does not explicitly disclose:

1. Means for selecting an entitlement management message intended for a detachable security element when said security element is not inserted in the decoder.
2. Means for storing said entitlement management message.

However, note in Fig 1 that the arrow which shows the direction of data flow moves away from filter 24 to interface 26. The dotted arrow between filter 26 and IC card 30 (i.e. the detachable security element) shows two-way communication between item 26 and item 30. It is obvious from Fig 1 that the filter 24, which filters out the entitlement management (EMM) message, does not get any information from the detachable security element. Therefore, even if the security element was detached, the filter would still select an EMM intended for said detachable security element even when

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said security element is not inserted into the decoder. One of ordinary skill might want to remove the detachable security element, for example, if the security element was some sort of parental control device and the parent could remove said device when they don't want their children to watch certain programs. The filter would still filter the EMM meant for the security device, but without the security device, certain programs cannot be watched.

Further, Chaney discloses means for storing said entitlement management message (col 6, lines 56-65). It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Muratani's decoder according to the limitations recited in claim 1 in light of Chaney's teachings. One of ordinary skill would have been motivated to do so as Chaney discloses that EMM's are relatively long term entitlement and typically occur infrequently in a signal (col 1, lines 55-60).

Claim 5:

Muratani does not explicitly disclose the detachable security element is a smart card. However, the examiner asserts that the IC card disclosed by Muratani reads on a smart card. Note that the IC card is used to authenticate a user via a password that was previously written onto the card (col 2, lines 43-48).

Claim 6:

Muratani does not explicitly disclose the identification parameter contained in the security element is the address of the smart card. However, Chaney discloses this limitation (col 10, lines 51-59). It would have been obvious to one of ordinary skill in the

art at the time the applicant's invention was made to have further modified Muratani and Chaney's combination decoder according to the limitation recited in claim 6 in light of Chaney's teachings. One of ordinary skill would have been motivated to do so as Chaney discloses that by including address information in EMM, a service provider can direct EMM to a particular card (col 10, lines 51-59).

Allowable Subject Matter

Claims 2-4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 2:

As per claim 2, the examiner could not find teachings in the prior art which discloses *a module for storing entitlements capable of reinstalling, following the erasure of the configuration of filters consequent upon the removal of said security element, the stored configuration of filters which is appropriate to said security element, in such a way as to select an entitlement management message intended for said security element when the latter is removed.* The examiner found art in which the filter was built into the security element, so once the security element was removed, the filter was also removed. The examiner also found art in which the filter's configuration was not dependent on the security element being inserted or not, therefore even if it was removed, the filter configuration was never erased. One of ordinary skill would not use either one of these teachings to arrive at the recited limitation though.

Claims 3-4:

Claims 3-4 depends on claim 2.

Claims 7-9 are allowed.

Claim 7:

Claim 7 contains a limitation substantially similar to claim 2, which the examiner believes is allowable over the prior art found. As per claim 7, the examiner did not find teaching in the prior art which discloses *transmitting said entitlement management message to said inserted security element, wherein the step of installing the configuration of filter which is appropriate to said security element is followed by a step of storing said configuration, when said security element is removed from the decoder, causing the erasure of said configuration of filters, the configuration of filters which is appropriate to the removed security element is reinstalled on the filters which is appropriate to the removed security element is reinstalled on the basis of the configuration stored during the storage step n such a way as to select an entitlement management message intended for said removed security element.*

Claims 8-9:

Claims 8-9 depend on claim 7.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 8:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP



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